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GROUP 3300
DIRECTOR'S OFFICE

Paper No. 29

In re Application of
Michael D. Quinn et al.
Application No. 08/420,503
Filed: April 12, 1995
For: THERMODILUTION CATHETER HAVING A SAFE, FLEXIBLE HEATING ELEMENT

DECISION ON PETITION

This is a decision on the petition filed March 19, 1997, which is being treated as a petition under 37 CFR 1.181 requesting that the above-identified application be forwarded to the Board of Patent Appeals and Interferences for declaration of an interference.

The petition is Denied.

Applicants argue that the examiner's refusal to initiate an interference between the above-identified application and Gallup et al. (U.S. Patent No. 5,435,308) is inappropriate. Applicants specifically assert that: (1) the claims of the above-identified application define patentable subject matter; and (2) the claims of the above-identified application define the same patentable subject matter as the claims in Gallup et al. within the meaning of 37 CFR 1.601(n). Applicants therefore argue that the circumstances at issue meet the conditions specified in 37 CFR 1.607 for the initiation of an interference between the above-identified application and Gallup et al.

37 CFR 1.607(b) provides that:

> When an applicant seeks an interference with a patent, examination of the application, including any appeal to the Board, shall be conducted with special dispatch within the Patent and Trademark Office. The examiner shall determine whether there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in an interference. If the examiner determines that there is any interfering subject matter, an interference will be declared. If the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared and otherwise act on the application.

Initially, it is brought to applicants' attention that an applicant has no standing to demand the initiation of an interference proceeding with an application or patent to another. See Godtfredson v. Banner, 503 F. Supp. 642, 646, 207 USPQ 202, 207 (D.D.C. 1980) (applicant has no standing to demand that the PTO initiate an interference with a pending application of another); Doyle v. Brenner, 383 F.2d 210, 154 USPQ 464 (D.C. Cir. 1967)(applicant has no standing to demand that the PTO initiate an interference with a patent of another). Nevertheless, the circumstances at issue do not meet the conditions specified in 37 CFR 1.607 for the initiation of an interference between the above-identified application and Gallup et al.

37 CFR 1.607(b) sets forth two (2) preconditions to the initiation of an interference between an application and a patent: (1) that there be "interfering subject matter claimed in the application and the patent"; and (2) that the interfering subject matter be "patentable to the applicant subject to a judgment in an interference."

Claims 45 through 64 are pending in the above-identified application. The Office action of April 1, 1997 includes: (1) a rejection of claim 55 under 35 U.S.C. § 112, first paragraph; (2) a rejection of claims 45 through 54 and 56 through 64 under 35 U.S.C. § 103 as unpatentable over Willis et al. (U.S. Patent No. 4,718,423) and Khalil (U.S. Patent No. 4,217,910); and (3) a rejection of claim 55 under 35 U.S.C. § 103 as unpatentable over Willis et al., Khalil, and Grise (U.S. Patent No. 4,814,586). That any claim in the above-identified application may have been previously indicated as allowable over the prior art of record is immaterial. MPEP 706.04 expressly contemplates that an allowed claim might be subject to a rejection in a subsequent Office action. The prior allowance of such a rejected claim has no relevance to the propriety of the rejection of such claim. Thus, the above-identified application contains no claim considered by the examiner to be patentable to applicants. It follows that the above-identified application contains no interfering subject matter considered by the examiner to be "patentable to the applicant subject to a judgment in an interference."

While claims 45 through 64 stand rejected under 35 U.S.C. § 103, applicants argue at length that claims 45 through 64 define patentable subject matter over Willis et al., Khalil, and Grise. It is axiomatic that differences of opinion between an applicant and the examiner as to the patentability of the claims are properly resolved by way of an appeal under 35 U.S.C. § 134 and 37 CFR 1.191 *et seq.*, not by way of petition under 37 CFR 1.181. See MPEP 1201. That applicants have couched an appealable issue (whether claims 45 through 64 define patentable subject matter over Willis et al., Khalil, and Grise) in the context of a petition under 37 CFR 1.181 does not cause this issue to be appropriate for resolution by way of petition.

As the interfering subject matter is not considered to be "patentable to the applicant subject to a judgment in an interference," whether any of the claims of the above-identified application define the same patentable subject matter as the claims in Gallup et al. within the meaning of 37 CFR 1.601(n) is immaterial. Accordingly, it would not be appropriate to forward the

above-identified application to the Board of Appeals and Interferences for declaration of an interference at this time.

Claims 45 through 64 may subsequently be determined (either by the examiner or by the Board of Patent Appeals and Interferences in an appeal under 35 U.S.C. § 134 and 37 CFR 1.191 *et seq.*) to be patentable. In such an event, this decision is without prejudice to applicants again requesting pursuant to 37 CFR 1.607 that an interference be initiated between the above-identified application and Gallup et al.

Summary: Petition Denied.

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